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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/699,517  
Filing Date: October 31, 2000  
Appellant(s): MCDONOUGH ET AL.

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McDonough et al.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 2, 2007 appealing from the Office action mailed June 13, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,874,023	Pennell et al.	03-2005
6,360,221	Gough et al.	3-2002
6,088,516	Kreisel et al.	07-2000
6,052,563	Macko	04-2000

5,936,554

Stanek

08-1999

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 35 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Stanek (USPN 5936554).

Regarding claim 35, Kreisel teaches a computer-readable medium having computer-executable instructions for performing steps comprising: (communication package (3) including memory containing incoming queue (23) and outgoing queue (25), col. 3, lines 14-17 and Fig. 1(b)) determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and communicating with a computer input device having an illumination member to cause the illumination member to change in response to the determining step, (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach establishing a set of senders and determining whether a sender of an incoming message is in the set.

On the other hand, Kreisel teaches a communications package 3 includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

Kreisel does not teach a communicating step includes causing the illumination member to change intensity.

Stanek (USPN 5936554) on the other hand teaches a computer program, whereby a computer 96 instructs a keyboard controller of keyboard 98 via communications link 100 to illuminate particular keys and dim other keys (Fig. 8 (98) and col. 8, lines 14-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's computer system (terminal), (2) shown in Fig. 1b to adapt Stanek's computer program with respect to keyboard illumination as demonstrated in Fig. 8 because the use of a program with respect to keyboard illumination helps establish has a bi-directional communication link between a keyboard and a computer as taught by Stanek (col. 4, lines 62-67).

Regarding claim 49, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step

(inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach establishing a set of senders and determining whether a sender of an incoming message is in the set.

On the other hand, Kreisel teaches a communications package 3 includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

Kreisel does not teach changing step includes casing the illumination to change intensity.

Stanek on the other hand teaches a computer program, whereby a computer 96 instructs a keyboard controller of keyboard 98 via communications link 100 to illuminate particular keys and dim other keys (Fig. 8 (98) and col. 8, lines 14-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's computer system (terminal), (2) shown in Fig. 1b to adapt Stanek's computer program with respect to keyboard illumination as demonstrated in Fig. 8 because the use of a program with respect to keyboard illumination helps establish has a bi-directional communication link between a keyboard and a computer as taught by Stanek (col. 4, lines 62-67).

3. Claims 33, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516).

Regarding claim 37, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach establishing a set of senders and determining whether a sender of an incoming message is in the set.

On the other hand, Kreisel teaches a communications package 3 includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize message storage as illustrated in computer system of Fig. 1b for the purpose of tracking the status of each message received (col. 3, lines 17-27).

Regarding claim 33, it would have been obvious to one of ordinary skill in the art mount kreisel's "LED control function" shown in Fig. 2 in any alternative input device since substitution of one type input device by another is well known in the art.

Regarding claim 40, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach whether a request to respond to one of a video conference call and an audio conference call has been received.

Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 62-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

4. Claims 41 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Pennell (USPN 6874023).

Regarding claim 41, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message)



and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach whether a user is capable of receiving a solicitation.

Pennell (USPN 6874023) on the other hand teaches generation of a unique email address for use in communicating with a web site as illustrated in Fig. 4 where a user receives email from the web site, whether solicited or unsolicited, such that the user is able to discern the sender of the email, as well as control future email correspondence with the web site (col. 1, lines 42-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Pennell's user control with respect to emails as indicated in Fig. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell (col. 1, lines 42-45).

Regarding claim 50, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach a determining step with respect to joining a chat room.

Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 62-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

Kreisel does not teach determining step including whether a request to respond to a solicitation has been received.

Pennell (USPN 6874023) on the other hand teaches generation of a unique email address for use in communicating with a web site as illustrated in Fig. 4 where a user receives email from the web site, whether solicited or unsolicited, such that the user is able to discern the sender of the email, as well as control future email correspondence with the web site (col. 1, lines 42-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Pennell's user control with respect to emails as indicated in Fig. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell (col. 1, lines 42-45).

5. Claims 42 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Macko (USPN 6052563).

Regarding claim 42, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach comparing a scheduled event time relative to an actual time set in the computer.

Macko (USPN 6052563) on the other hand teaches an email-forwarding program in a PC 130 which is activated at an appropriate time corresponding to the scheduled appointment (col. 8, lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Macko's email forwarding program (700) as configured in Fig. 13 because an email forwarding program helps automatically forward emails to a communication device (100) as taught by Macko.

Regarding claim 17, Macko teaches said determining step includes determining whether the actual time set in the computer is the same as the scheduled event time (col. 8, lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

Regarding claim 18, Macko teaches said determining step includes determining whether the actual time set in the computer has reached a time prior to the scheduled event time (col. 8, lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

6. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Suzuki et al. (USPN 5890139).

Regarding claim 43, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach determining whether a correct answer has been input.

Suzuki et al. (USPN 5890139) on the other hand teaches an information answering system in which not-yet-answered case processing unit 160 edits an input answer into the electronic mail format and transfers it to the electronic mail transmission unit 180 (Fig. 5 (109) and col. 7, lines 8-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Suzuki's answer transmission via email (109) as configured in Fig. 5 because the use of answer transmission via email helps function online shopping as taught by Suzuki (col. 1, lines 6-7).

7. Claims 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Gough et al. (USPN 6360221).

Regarding claim 44, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach the determining step including one of a state, a characteristic, and a condition relating to a character in a game program.

Gough et al. (USPN 6360221) on the other hand teaches an enhanced interactive e-mail system implementing a chess game program, which remembers positions, enforces rules (Fig. 13, col. 15, lines 66-67 and col. 16, lines 1-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Gough's enhanced interactive email driven game as demonstrated in Fig. 13 because the use of enhanced interactive email helps attract users and members to the website as taught by Gough (col. 2, lines 45-49).

Regarding claim 45, Gough teaches said determining step includes determining whether the character is within a given proximity of an object (col. 15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game program which remembers positions, enforces rules etc. It would have been obvious to utilize Kreisel's email- based flashing with respect Gough's email-based chess game program).

Regarding claim 46, Gough teaches said changing step includes the illumination member to change states in a manner corresponding to a number of lives remaining for the character (col. 15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game program which remembers positions, enforces rules etc. For one of ordinary skill, it would be obvious to reprogram Gough's chess game for additional functionalities. It would also have been obvious to utilize Kreisel's email- based flashing with respect Gough's email-based chess game program).

Regarding claim 47, Gough teaches said changing step includes causing the illumination member to change states in a manner corresponding to an amount of supply for the character (col. 15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game program which remembers positions, enforces rules etc. For one of ordinary skill, it would be obvious to reprogram Gough's chess game for additional functionalities. It would also have been obvious to utilize Kreisel's email- based flashing with respect Gough's email-based chess game program).

Regarding claim 48, Gough teaches said changing step includes casing the illumination member to change states in a manner corresponding to the character entering an area in the game program (col. 15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game program which remembers positions, enforces rules etc. For one of ordinary skill, it would be obvious to reprogram Gough's chess game for additional functionalities. It would also have been obvious to utilize Kreisel's email- based flashing with respect Gough's email-based chess game program).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 39 and 51-52 is rejected under 35 U.S.C. 102(c) as being anticipated by Kreisel et al. (USPN 6088516).

Regarding claims 39 and 52, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46), wherein said determining step includes determining step includes determining whether an instant message has been received (Fig. 2(202) and col. 8, lines 65, flag identifying incoming mail) and determining whether an email message has been received (Fig. 2 (404), evaluates the state of Flag (true or false ), col. 8, lines 66) wherein said changing step includes changing the state associated with the illumination member to a first state in response to determining an instant message has been received (col. 8, lines 66-67, if the mail flag is false, no mail has been received) and changing the state associated with the illumination member to a second state in response to determining an email message has

been received (col. 9, lines 2-10, if mail flag is true, if LED is ON, it turns OFF, if LED is already OFF, it turns ON).

Regarding claim 51, the first state and the second state are different states (col. 9, lines 2-10).

In addition, with respect to claim 52, note that Kriesel teaches that the Scroll Lock LED may be controlled to flash at a given rate regardless of the number of new message (col. 9, lines 10-21).

#### **(10) Response to Argument**

##### Independent Claims 35 and 49

Appellants argue that the cited references Kreisel et al. (USPN 6088516) and Stanek (USPN 5936554) alone or in combination do not teach establishing a set of senders and determining whether a sender of an incoming message is in the set. The examiner respectfully disagrees with appellants' argument. Kreisel teaches a communications package 3 includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize message storage as illustrated in computer system of Fig. 1b for the purpose of tracking the status of each message received (col. 3, lines 17-27).



Independent claim 37

Appellants argue that the cited reference Kreisel et al. (USPN 6088516) does not teach establishing a set of senders and determining whether a sender of an incoming message is in the set. The examiner respectfully disagrees with appellants' argument. Kreisel teaches a communications package 3 includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize message storage as illustrated in computer system of Fig. 1b for the purpose of tracking the status of each message received (col. 3, lines 17-27).

Independent Claim 39

Appellants argue that the cited reference, Kreisel (USPN 6088516) does not teach, a claim limitation "determining step includes determining whether an instant message has been received wherein said changing step includes changing the state associated with the illumination member in response to determining an instant message has been received". The examiner respectfully disagrees with appellants' argument. Kreisel teaches that when receiving a new message, the receipt of the new message is indicated by flashing an LED on input device (col. 8, lines 39-47). Kreisel teaches as shown in Fig. 2, a processing sequence (LED control function) performed at set intervals when called (step 200) such that when calling takes place, the LED

control function reads a global or system variable or flag identifying incoming mail (step 202) (Fig. 2(200, 202), col. 8, lines 61-67).

#### Independent Claim 40

Appellants argue that the cited reference Kreisel et al. (USPN 6088516) does not teach the determining step including whether a request to respond to one of a video conference call and an audio conference call has been received. The examiner respectfully disagrees with appellants' argument. Kreisel teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 62-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

#### Independent Claim 41

Appellants argue argues that the cited references, Kreisel et al. (USPN 6088516) and Pennell (USPN 6874023) alone or in combination do not teach "whether a user is capable of receiving a solicitation". The examiner respectfully disagrees with appellants' argument. Pennell (USPN 6874023) teaches generation of a unique email address for use in communicating with a web site as illustrated in Fig. 4 where a user receives email from the web site, whether solicited

or unsolicited, such that the user is able to discern the sender of the email, as well as control future email correspondence with the web site (col. 1, lines 42-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Pennell's user control with respect to emails as indicated in Fig. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell (col. 1, lines 42-45).

#### Independent Claim 42

Appellants argue that the cited references Kreisel et al. (USPN 6088516) and Macko (USPN 6052563) alone or in combination do not teach "determining step, which includes comparing a scheduled event time relative to an actual time set in the computer". The examiner respectfully disagrees with appellants' argument. Macko (USPN 6052563) teaches an email-forwarding program in a PC 130 which is activated at an appropriate time corresponding to the scheduled appointment (col. 8, lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Macko's email forwarding program (700) as configured in Fig. 13 because an email forwarding program helps automatically forward emails to a communication device (100) as taught by Macko.

Independent Claim 43

Appellants argue that the cited references, Kreisel et al. (USPN 6088516) and Suzuki et al. (USPN 5890139) alone or in combination do not teach “determining step including determining whether a correct answer has been input”. The examiner respectfully disagrees with appellants’ argument. Suzuki et al. (USPN 5890139) teaches an information answering system in which not-yet-answered case processing unit 160 edits an input answer into the electronic mail format and transfers it to the electronic mail transmission unit 180 (Fig. 5 (109) and col. 7, lines 8-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel’s email communication shown in Fig. 1b to adapt Suzuki’s answer transmission via email (109) as configured in Fig. 5 because the use of answer transmission via email helps function online shopping as taught by Suzuki (col. 1, lines 6-7).

Independent Claim 44

Appellants argue that the cited references Kreisel et al. (USPN 6088516) and Gough et al. (USPN 6360221) alone or in combination do not teach “determining step including one of a state, a characteristic, and a condition relating to a character in a game program. The examiner respectfully disagrees with appellants’ argument. Gough et al. (USPN 6360221) teaches an enhanced interactive e-mail system implementing a chess game program, which remembers positions, enforces rules (Fig. 13, col. 15, lines 66-67 and col. 16, lines 1-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Gough's enhanced interactive email driven game as demonstrated in Fig. 13 because the use of enhanced interactive email helps attract users and members to the website as taught by Gough (col. 2, lines 45-49).

#### Independent Claim 50

Appellants argue that the cited references, Kreisel et al. (USPN 6088516) and Pennell (USPN 6874023) alone or in combination do not teach, a claim limitation "said determining step includes determining whether a request to respond to a solicitation to join a chat room has been received" The examiner respectfully disagrees with appellants' argument.

Kreisel does not specifically teach a determining step with respect to joining a chat room.

Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 62-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

Kreisel does not teach determining step including whether a request to respond to a solicitation has been received.

Pennell (USPN 6874023) on the other hand teaches generation of a unique email address for use in communicating with a web site as illustrated in Fig. 4 where a user receives email from the web site, whether solicited or unsolicited, such that the user is able to discern the sender of the email, as well as control future email correspondence with the web site (col. 1, lines 42-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Pennell's user control with respect to emails as indicated in Fig. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell (col. 1, lines 42-45).

#### Independent Claim 52

Appellants argue that the cited reference, Kreisel (USPN 6088516) does not teach, a claim limitation, "communicating with the computer input device having the illumination member to cause the illumination member to change to a third state in response to determining that the predetermined event corresponds to input of a correct answer". The examiner respectfully disagrees with appellants' argument. Kreisel teaches as shown in Fig. 2 the LED controller changes the state of the scroll lock LED each time a function is called , so long as the New Mail Flag is true , such that when new mail exists, the state of a Scroll Lock LED is alternated between ON and OFF (col. 9, lines 7-17).

In response to appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's computer system (terminal), (2) shown in Fig. 1b to adapt Stanek's computer program with respect to keyboard illumination as demonstrated in Fig. 8 because the use of a program with respect to keyboard illumination helps establish a bi-directional communication link between a keyboard and a computer as taught by Stanek (col. 4, lines 62-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Pennell's user control with respect to emails as indicated in Fig. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell (col. 1, lines 42-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Macko's email forwarding program (700) as configured in Fig. 13 because an email forwarding program helps automatically forward emails to a communication device (100) as taught by Macko. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Suzuki's answer transmission via email (109) as configured in Fig. 5 because the use of answer transmission via email helps function online shopping as taught by Suzuki (col. 1, lines 6-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Gough's enhanced interactive email driven game as demonstrated in Fig. 13 because the use of enhanced interactive email helps attract users and members to the website as taught by Gough (col. 2, lines 45-49).

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Abbas Abdulsalam/

/A. I. A./

Primary Examiner, Art Unit 2629



Art Unit: 2629

Conferees:

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